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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/677,746      | 10/03/2000  | Michael E. Reedy     | 3142/34             | 4391             |

27383 7590 05/15/2003

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EXAMINER

KUHNS, ALLAN R

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 05/15/2003

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MAILED  
MAY 15 2003  
GROUP 1700

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 15

Application Number: 09/677,746

Filing Date: October 3, 2000

Appellant(s): Michael E. Reedy and Edward W. Rider, Jr.

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Philip E. Roux

For Appellant

Art Unit: 1732

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 27, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is substantially correct. However, based on the Revised Reissue Declaration filed March 3, 2003, the rejection of claims 1-18 under 35 U.S.C. 251 is hereby withdrawn. Claims 1-18 are now allowable, although at this time, claims 1-50 are grouped together.

**(4) *Status of Amendments After Final***

The appellants' statement regarding the status of amendments after final is substantially correct.

Art Unit: 1732

No amendment was filed in the response after final filed August 26, 2002. The citations by appellants denoting support in the disclosure of issued patent 5,817,261 for claims 19-50, also filed August 26, 2002, is acceptable to the examiner.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellants' statement of the issues in the brief is substantially correct. The changes are as follows: based on the Revised Reissue Declaration filed March 3, 2003, there are no remaining issues with regard to claims 1-18.

**(7) *Grouping of Claims***

Appellants have chosen to group claims 1-50 together. The rejection of claims 19-50 stands or falls together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192 (c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37

Art Unit: 1732

CFR 1.175(a)(1) and MPEP 1414. Claim 2 of parent application Ser. No. 07/995,289, directed to a composition (including the constituents of the additive now claimed in claims 19-32 and the constituents of the polymer composition now claimed in claims 33-50 of this reissue application), was subjected to a restriction requirement, was a non-elected invention and was subsequently canceled during the prosecution of Ser. No. 07/995,289. A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). It is noted that the claims of 07/995,289 (Pat. No. 5,269,987), continuing application 08/163,010 (Pat. No. 5,595,694), and continuing application 08/702,922 (Pat. No. 5,817,261), the application for which reissue is being sought, are all directed to a method of making a foam, in particular an alkenyl aromatic foam.

Claims 19-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

**(11) *New Ground of Rejection***

This examiner's answer does not contain any new ground of rejection.

**(12) *Response to Argument***

Appellants first note the examiner's comments in the Office action mailed February 26, 2002 that if the newly added claims 19-50 (filed with the reissue application on October 3, 2000) are considered by appellants to be overbroad, then the filing of these claims with the reissue application had the effect of introducing error into the reissue application, rather than correcting any error in the issued patent

Art Unit: 1732

(5,817,261). Appellants then state that the examiner's comments are incorrect and misleading because an error was corrected. The examiner is maintaining this position originally set forth in the Office action mailed February 26, 2002. At lines 1-5 of the amendment and response filed November 26, 2001, appellants state that "(c)laims 19 and 33, added in the reissue application, have likewise been amended to recite that the additive "consists essentially of" rather than "comprises". Prior to the proposed amendment, the open-ended phraseology used with respect to the additive may have been overbroad and rendered claims 19-50 invalid, also in view of applicants' prior U.S. Patent Nos. 5,218,006, 5,302,624, 5,342,857 and 5,403,865.". To the examiner, these remarks essentially constitute an admission that the initial filing of claims 19-50, with the transition phrase "comprising" in claims 19 and 33, introduced an error into the application.

Appellants also argue that the examiner's statement that failure to timely file a divisional application is effectively the error leading to the filing of claims 19-50 is incorrect and not supported by the facts. Appellants then note that they have repeatedly stated that a failure to timely file a divisional application is not an error upon which this reissue application is being based. Appellants also note that the reissue declaration dated November 26, 2001 indicates the error as "claiming more than we had a right to claim. But the original reissue declaration filed October 3, 2000 states "(w)e believe the original patent to be wholly or partly inoperative or invalid by reason of our claiming less than we had a right to claim by failing to obtain claims of varying type and scope. In particular, the error on which reissue is based is that in the original application, we failed to claim an additive suitable for use in a foamable polymer composition, and a foamable polymer composition comprising an alkenyl aromatic polymer and an additive. This error was made without any deceptive intent, and is corrected by the addition of

Art Unit: 1732

new claims 19-50.”

Appellants argue that none of the prior patents to have issued from (the parent) application contain claims to an additive per se, such that the presently claimed additives could not have been subjected to a restriction requirement. But, as discussed in the ground of rejection set forth above, claim 2 of parent application Ser. No. 07/995,289, directed to a composition, including the constituents of the additive now claimed in claims 19-32 and the constituents of the polymer composition now claimed in claims 33-50 of this reissue application, was the subject of a restriction/election requirement.

Appellants also note that in each of the prior applications to which a restriction requirement was directed (07/995,289, 08/163,010 and 08/702,922), those restriction were all traversed. But, even though appellants used the word “traverse” in each application, appellants actually acquiesced to the restriction each time. In fact, at the very same time that appellants traversed the restriction requirement in 07/995,289, they directed the examiner of that application to cancel the non-elected claims by Examiner’s Amendment in a first Office action issue. Then in 08/163,010, while appellants responded with a traversal, they actually canceled the non-elected claims at the very same time, rendering the traversal moot. Perhaps, more importantly, appellants in each case chose not to file a divisional application directed to the additive or to a composition containing the additive.

Appellants further argue that the claims added in the reissue application are tied directly to the process claims which were patented in the patent for which the reissue is sought and should have been prosecuted with the process claims when they were presented in parent application 08/702,922. It is noted by the examiner that appellants admit that such claims were previously presented. However, it is unclear to the examiner why such claims should have been prosecuted with the process claims since they

Art Unit: 1732

are/were directed to a different statutory class of invention.

Appellants also assert that the examiner's reliance on In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977) is misplaced since the facts from this reissue application are distinguishable from that case wherein the restriction was not traversed. The examiner disagrees because in Orita, there was a traverse that was not perfected (193 USPQ at 146). In addition, the court in Orita (193 USPQ at 148) focused on the fact that, as in the reissue application now at issue, there was an acquiescence to the restriction requirement.

Appellants instead rely on In re Doyle, 293 F.3d 1355 (Fed. Cir. 2002) in support of their position. But the issues in Doyle are quite different from those in the instant application. In Doyle, the issue involved genus and species claims directed to the same statutory class of invention, which is not so in the application at issue. Furthermore, in Doyle, linking claims were present such that the claims actually could have been prosecuted with the elected group. The examiner notes appellants' contention that the examiner has failed to distinguish the situation in Doyle from that of the present application, but the examiner is maintaining the position that Doyle has been distinguished.

Appellants' arguments with regard to a defective reissue application concerning claims 1-18 are also noted by the examiner, but these arguments are considered to be moot by the examiner based on the change of position by the examiner following receipt of the Revised Reissue Declaration filed March 3, 2003.



Art Unit: 1732

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*Allan R. Kuhns*

ALLAN R. KUHNS  
PRIMARY EXAMINER

April 19, 2003

Conferees

*RC*

*John M. ...*